

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Date: 12/23/2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diamond Girl Corporation

Serial No. 78194018

Jay F. Moldovanyi and Sandra M. Koenig of Fay, Sharpe,
Fagan, Minnich & McKee for applicant.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Quinn and Grendel, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Diamond Girl Corporation
to register the mark DIAMOND GIRL ("GIRL" disclaimed) for
"skin lotions and creams; body soaps sold in specialty
stores featuring personal care products, namely, beauty
shops, beauty supply stores and cosmetic and toiletry
stores."¹

¹ Application Serial No. 78194018, filed December 12, 2002,
based, under Section 1(b) of the Trademark Act, on an allegation
of a bona fide intention to use the mark in commerce, and, under
Section 44(d) of the Trademark Act, on a claim of priority based

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark DIAMOND GIRL for "footwear and clothing; namely, sweatshirts, T-shirts, shirts, blouses, body suits, underwear, pajamas, robes, pants, skirts, dresses, jackets, coats, suspenders, belts, gloves, hats, sun visors and head bands"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney highlights the fact that the involved marks are identical, and argues that the marks convey identical commercial impressions. According to the examining attorney, the goods are also related. In this connection, the examining attorney relies upon third-party registrations to show that cosmetics and clothing often emanate from the same source under the same mark and are offered in the same channels of trade. The examining attorney, while acknowledging the limitation in applicant's

upon a foreign application (later maturing into Canadian Registration No. TMA607239).

² Registration No. 1893486, issued May 9, 1995; renewed.

identification of goods, notes that registrant's identification of goods does not include any limitations: "Since the identification of the registrant's goods is very broad, it is also presumed that the registration encompasses all goods of the type described, including those in the applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers including those who visit beauty shops, beauty supply stores and cosmetic and toiletry stores." (Brief, unnumbered p. 4). Lastly, the examining attorney asserts that any doubt must be resolved in registrant's favor.

Applicant contends that it has narrowed the identification of goods in the involved application to very specific trade channels, and that beauty shops, beauty supply stores, and cosmetic and toiletry stores are not outlets where clothing and footwear are sold, thereby avoiding likelihood of confusion with registrant's mark. In addressing the examining attorney's third-party registration evidence, applicant states that it is not seeking a registration for retail store services. Further, applicant argues, although department stores and the like sell both clothing and skin and hand care products, applicant's identification of goods excludes trade channels

that correspond to clothing and footwear. Applicant asserts, in any event, that the goods are neither related nor complementary, pointing out that "one does not purchase special creams, lotions or bath soaps to go with a particular pair of shoes or a particular item of clothing." (Brief, p. 7). With respect to the marks, applicant states that both "DIAMOND" and "GIRL" are weak terms, and, in this connection, applicant relies upon many registrations of DIAMOND-formative marks registered for clothing in Class 25 and for cosmetics in Class 3. Applicant also argues that the marks convey different meanings and commercial impressions; applicant's mark "gives the impression of pampering, such as where a girl deserves the best," whereas registrant's mark "gives the impression of sparkled material." Id.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or

services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The marks are identical. They sound the same and they look the same. Contrary to applicant's contentions, we find that the marks have similar meanings when applied to the respective goods of applicant and registrant. Despite the fact that the marks are used with different goods, they still convey the same meaning and engender the same overall commercial impression.³ Cf. *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984)[PLAYERS, when applied to shoes and men's underwear, has different connotations].

Although we have considered the third-party registrations of DIAMOND-formative marks, this evidence is of limited probative value. The registrations are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476

³ We take judicial notice of the dictionary listing of "diamond." The word means, among other things, "something that resembles a diamond (as in value, rarity, or brilliance)." Webster's Third New International Dictionary (unabridged ed. 1993). Both marks convey a classy and upscale image.

F.2d 1004, 177 USPQ 462 (CCPA 1973); and Richardson-Vicks, Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982).

Any value that these registrations have to the likelihood of confusion analysis is limited to their showing, as in the case of a dictionary listing, the sense in which the term "Diamond" is employed in the language. Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984). In this case, the registrations show that the term "DIAMOND" has in the past appealed to others in the clothing and cosmetics field as an appropriate designation for a mark or part of a mark to convey an upscale image. Red Carpet Corp. v. Johnstown American Enterprises, Inc., 7 USPQ2d 1404, 1406 (TTAB 1988).

The justification of consideration of third-party registrations is that the presence in marks of common elements extensively adopted by others, unrelated as to source, may cause purchasers to not rely upon such elements as source indicators but to look to other elements as a means of distinguishing the source of the goods. The overriding problem with applicant's position is that the present case involves identical marks, and therefore there is no additional element in either mark which might serve to distinguish them. The record is devoid of any third-

party registrations of the mark DIAMOND GIRL; the only registration is the one cited by the examining attorney. Inasmuch as there is only one registration of the mark DIAMOND GIRL, and the record does not include any third-party uses of the mark, we find the cited mark to be arbitrary and strong for clothing and footwear. This finding, coupled with the identity between the marks, weighs heavily in favor of affirmance of the likelihood of confusion refusal.

With respect to the goods, as pointed out by the examining attorney, where identical marks are involved, as is the case here, the degree of similarity between applicant's and registrant's goods that is required to support a finding of likelihood of confusion is less. In *re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

Turning to the goods, we must base our comparison on the identifications in the application and the cited registration. In *re Shell Oil Co.*, supra at 1690, n. 4. It is not necessary that the respective goods be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some

manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

We note, at the outset of comparing the goods, that "while confusion has been held likely in a number of cases....involving cosmetic or toiletry products on the one hand and various items of clothing on the other, there is of course no per se rule that there is a likelihood of confusion when the same or similar mark is applied to these respective goods." In re Jacques Bernier Inc., 1 USPQ2d 1924, 1925 (TTAB 1987).

The examining attorney has made of record a number of third-party registrations that show entities have registered a single mark for clothing and cosmetics. See, e.g., Registration No. 2567211 (NATURE'S HEALING PRODUCTS for skin care products and clothing); Registration No. 2814691 (ZINKA for non-medicated skin care preparations and clothing); Registration No. 2413643 (JOBH for creams and lotions and clothing); and Registration No. 2515615 (PUA for cosmetics and skin care products and clothing).

Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

In view of the third-party registrations, it is reasonable to conclude that clothing and cosmetics are commercially related. Further, the evidence suggests that consumers have been exposed to cosmetics and clothing emanating from the same source under the same mark.

The crux of the refusal herein centers on whether or not the limitation pertaining to trade channels as reflected in applicant's identification of goods ("sold in specialty stores featuring personal care products, namely, beauty shops, beauty supply stores and cosmetic and toiletry stores") is sufficient to avoid a likelihood of confusion with registrant's identical mark for clothing. Although the limitation makes this a closer case, we find that the record establishes a likelihood of confusion.

Given the limitation in applicant's identification of goods, we agree with applicant that its cosmetics are sold in different trade channels than are registrant's clothing

and footwear. We are not persuaded by the examining attorney's argument that, because registrant's identification of goods is not limited as to trade channels, the clothing and footwear could be sold in the same channels of trade as applicant's cosmetics. Without evidence in support of this contention, we simply cannot accept the examining attorney's statement that clothing is presumed to be sold in beauty shops, beauty supply stores and cosmetic and toiletry stores. While the examining attorney has relied on third-party registrations of marks for retail store services featuring, among other things, clothing and cosmetics, there is no evidence to suggest that the types of retail stores referred to in these registrations are the types of personal care specialty stores in which applicant's products, as identified in the application, could be sold.⁴ There simply is no evidence to show this to be true. The difference in trade channels weighs in favor of applicant's position.

The fact that applicant's cosmetics may be sold only in personal care specialty stores, however, is insufficient

⁴ Given the range of goods featured in some of the retail store services (see, e.g., Registration No. 2710538 that lists retail store services featuring not only clothing and cosmetics, but also leather bags, eyewear, and jewelry), it is reasonable to say that these retail stores are not beauty shops, beauty supply stores, or cosmetic and toiletry stores.

to distinguish source when the goods are sold under identical marks. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992)[likelihood of confusion found between MOUNTAINHIGH 1 for coats sold in applicant's store and MOUNTAIN HIGH for retail outlet services for camping and mountain climbing equipment]. Purchasers who shop in personal care specialty stores also shop in retail outlets where clothing is sold. A consumer who is familiar with DIAMOND GIRL brand clothing that she buys at a retail apparel store at the mall, and who then goes into a cosmetics specialty store and encounters DIAMOND GIRL brand skin lotions, creams and body soaps, likely will believe that the goods originate from the same source. In the past, the Board has found likelihood of confusion when the identical mark is applied to items of clothing and cosmetics. See *In re Barbizon International, Inc.*, 217 USPQ 735 (TTAB 1983)[BARBIZON--"[T]he fact that goods are not sold together or through the same outlets does not matter, especially where identical marks are involved, if they are shown to be related in some manner and could be encountered by the same persons under conditions that might suggest a common origin."]; and *In re Cosmetically Yours, Inc.*, 171 USPQ 563 (TTAB 1971)[DATE MATES] and cases cited therein.

Insofar as the classes of purchasers are concerned, there is an overlap. It is clear that both clothing and cosmetics are bought by the same purchasers, namely, ordinary consumers. Although the record is silent on the cost of the respective goods, we must assume that the clothing and cosmetics may be at any price point. In the case of relatively inexpensive clothing and cosmetics, consumers may be expected to exercise nothing more than ordinary care in their purchasing decisions.

We conclude that consumers familiar with registrant's clothing and footwear sold under its mark DIAMOND GIRL would be likely to believe, upon encountering applicant's mark DIAMOND GIRL for skin lotions and creams, and body soaps sold in specialty stores featuring personal care products, namely, beauty shops, beauty supply stores and cosmetic and toiletry stores, that the goods originate with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In *re Hyper Shoppes (Ohio), Inc.*, supra; and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

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Decision: The refusal to register is affirmed.